



CP 232

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10-2/91

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)

GILBERT P. HYATT)

Serial No. 06/848,017)

Docket No. 307)

Filed: April 3, 1986)

For: AN INTEGRATED CIRCUIT FILTER)
PROCESSOR)

Group Art Unit 232

Examiner: Robert B. Harrell

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GROUP 230

AMENDMENT UNDER 37 CFR 1.111

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

In response to the Action dated June 5, 1991 (Paper No. 9); please enter the selection of claims and please amend the present application as set forth in Sections I and III hereinafter as provided for under 37 CFR 1.111. Further, the Applicant requests reconsideration for the reasons set forth in Section II hereinafter as provided for under 37 CFR 1.111.

I SELECTION WITH TRAVERSE

The Examiner has entered a multiplicity rejection and has required that the Applicant select 30 claims or less for examination which differ substantially. The Applicant hereby selects the following 30 claims with traverse in order to reserve his right to appeal the multiplicity rejection. The provisionally selected claims are claims 5, 41, 43, 44, 47, 49, 50, 53, 55, 56, 59, 60, 62, 64-66, 68, 69, 71-73, 76, 77, 83-87, 91, and 92.

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II REMARKS

2.1 Multiplicity Rejection

Claims 5 and 41-97 stand rejected for multiplicity. The Applicant respectfully traverses the multiplicity rejection for

the reasons set forth below and the Applicant reserves his right to appeal this rejection.

The claims in the present application satisfy 37 CFR 1.75(b) because they "differ substantially from each other" and are not unduly multiplied.

It is well established that "[t]he examiner should be reasonable in setting the number [of claims] to afford the applicant some latitude in claiming his invention." (MPEP 706.03(1)). The 58 claims in the present application is a reasonable number in view of the subject matter of the invention. The present multiplicity rejection is in violation of the current case law infra where the Board reversed such multiplicity rejections. Clearly, the multiplicity rejection in the present application is similarly inconsistent with the law and should be withdrawn.

"OPINION

With respect to the rejection of all the claims under 35 U.S.C. 112 as being unduly multiplied, it is manifestly untenable. In re Wakefield, 442 F.2d 897, 164 USPQ 636 (CCPA 1970). ***

Accordingly, all grounds of rejection advanced by the examiner are reversed."

(In re Hyatt; application Serial No. 06/520,277; PTO Appeal No. 88-0854; unpublished Board Decision; Paper No. 24; pages 3 and 5).

"In rejecting the claims under 35 U.S.C. 112, second paragraph, the examiner states that the claims are prolix, citing Ex parte Iagan, 1911 CD 10; 162 O.G. 538, and In re Ludwick, 1925 CD 306, 339 O.G. 393. The examiner's apparent position is that the myriad of different incongruent elements recited with the converter system results in the addition of material which serves to obfuscate rather than clarify the invention.

We disagree with the examiner. The statement in Ex parte Birnbaum, 161 USPQ 635 (PO Bd.App. 1969).

While forty pages of claims may seem to be unnecessarily prolix, the mere psychological reaction to this amount of material does not, in and of itself, constitute a legal basis for the rejection

is appropo. With respect to the sixty-seven claims on appeal, the observations in In re Wakefield, 422 F.2d 897, 164 USPQ 636 (CCPA 1970), are pertinent



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TRANSMITTAL LETTER GROUP 230

COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is:

1. AMENDMENT UNDER 37 CFR 1.111.

The fees are calculated below.

CLAIMS AS AMENDED

Claims Remaining After Amendment		Highest No. Prev. Paid For		Present Extra	Rate	Additional Fee
Total Claims	58	Minus 58	=	0	X \$10.00 =	\$ 0.00
Indep Claims	22 21	Minus 13 12	=	9	X \$30.00 =	\$ 270.00
Total Fee (Small Entity)						\$ 270.00

Charge \$ 270.00 to Deposit Account No. 08-3626. A
Declaration claiming small entity status has been filed herein.

Please charge any fees associated with the papers transmitted herewith to Deposit Account No. 08-3626,
including any fees for extension of time that may be required but are not set forth above. A Declaration
claiming small entity status has been filed herein.

CERTIFICATION OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on the date set forth below.

Respectfully submitted,

Dated: September 5, 1991

A handwritten signature in cursive script, reading "Gilbert P. Hyatt", written over a horizontal line.

Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 3357
Cerritos, CA 90703
Phone (714) 995-1087